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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/986,650	11/09/2001	Derek Ward	P67300US0	5599
136 7590 07/27/2009 JACOBSON HOLMAN PLLC 400 SEVENTH STREET N.W. SUITE 600 WASHINGTON, DC 20004				
EXAMINER JARRETT, RYAN A				
ART UNIT 2121		PAPER NUMBER		
MAIL DATE 07/27/2009		DELIVERY MODE PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

09/986,650

Applicant(s)

WARD, DEREK

Examiner

RYAN A. JARRETT

Art Unit

2121

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 16 April 2009.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 3, 4, 8-19, 22-26, 29-31 and 33-49 is/are pending in the application.
4a) Of the above claim(s) 8-19, 23-26 and 29-31 is/are withdrawn from consideration.
- 5) ☒ Claim(s) 43-49 is/are allowed.
- 6) ☒ Claim(s) 3, 4, 22, 33, 35 and 36 is/are rejected.
- 7) ☒ Claim(s) 34 and 37-42 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 09 November 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Priority

Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.

Claim Objections

Claims 33, 45, and 47 are objected to because of the following informalities:

In claim 45 line 3, “section” should be changed to “sections”.

Claims 33 and 47 both recite “the programmable device configuration process”. Examiner recommends changing this to “the programmable configuration process”, since there is no antecedent basis for “the programmable device” in the claims.

Appropriate correction is required.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 3, 4, 22, 33, 35, and 36 are rejected under 35 U.S.C. 102(e) as being anticipated by How et al. US 6,611,932. For example, How et al. discloses:

3. A programmable controller for use with a monitoring device, said programmable controller including:

at least one digital input interface (e.g., Fig. 1 #A),

at least one digital output interface (e.g., Fig. 1 #B) for receiving data from at least one output register,

programmable logic hardware including a plurality of logic elements including flip-flops, and electrically configurable interconnections, said interconnections configurable to interconnect the logic elements as a logic circuit, said logic processing circuit arranged to implement a user control program defined by a user as a user control program circuit, said logic processing circuit configurable in said programmable logic hardware, and connected to said input interfaces and said output interfaces (e.g., abstract),

program loading circuits for configuring said programmable logic hardware with said logic processing circuit prior to initiating control, and where said programmable logic hardware, configured with the logic processing circuit (e.g., abstract), includes:

a plurality of logic processing circuit flip-flops for storing state data, and for each of these flip-flops, an associated support circuit, the support circuits arranged to operate selectively between first and second conditions (e.g., abstract: “each logic block is further equipped for addressable mode control”), wherein in said first condition (e.g., abstract: “freeze mode”) the support circuits connect the flip-flops as a shift register for transporting state data into and out of the logic processing circuit (e.g., abstract: “When the logic blocks are selected to be frozen, the logic blocks behave as a series of daisy-chained master-slave flip-flops”), and wherein in the second condition (e.g., abstract: “normal mode”) the support circuits connect the flip-flops as logic elements of said user control program (e.g., abstract: “normal mode is defined by the user-designed circuit”), the support circuits being selected to operate in only one of either the first condition or the second condition at any one time (e.g., abstract: “each logic block is further equipped for addressable mode control”).

4. The programmable controller as claimed in claim 3, further including:

a monitoring services and control unit arranged to control and operate said logic processing circuit including:

a continuously cycling logic processing scan at least including said support circuits in both said first condition and said second condition, and when in said first condition said support circuits are arranged to operate to shift state data out of and into said logic processing circuit to provide read and write access to said plurality of logic processing flip-flops (e.g., abstract: “When the logic blocks are selected to be frozen, the logic blocks behave as a series of daisy-chained master-slave flip-flops”); and when in said second condition said programmable controller is arranged to operate to apply user clock pulses to said logic processing circuit and to

update said at least one output register (e.g., abstract: “normal mode is defined by the user-designed circuit”, Fig. 1 #108,109).

22. The programmable controller as claimed in claim 4, wherein said monitoring services and control unit is arranged to:

operate said at least one output register, when said support circuits are operated according to said first condition, to ensure the output data in said at least one output register remains unchanged from the output data last stored from the user control program circuit when said support circuits were operated according to said second condition (e.g., col. 2 lines 30-34: “at any time when the clocks are stopped, the flip-flops will maintain the state of the circuit”).

33. The programmable controller as claimed in claim 3 wherein the flip-flops connected as a shift register (e.g., abstract: “the logic blocks behave as a series of daisy-chained master-slave flip-flops”) have their order in the shift register determined by programmable logic device configuration (e.g., abstract: “the user-designed circuit”).

35. The programmable controller as claimed in claim 33, further including:

a monitoring services and control unit arranged to control and operate said logic processing circuit including:

a continuously cycling logic processing scan at least including said support circuits in both said first condition and said second condition, and when in said first condition said support circuits are arranged to operate to shift state data out of and into said logic processing circuit to provide read and write access to said plurality of logic processing flip-flops (e.g., abstract: “When the logic blocks are selected to be frozen, the logic blocks behave as a series of daisy-chained master-slave flip-flops”); and when in said second condition said programmable

controller is arranged to operate to apply user clock pulses to said logic processing circuit and to update said at least one output register (e.g., abstract: "normal mode is defined by the user-designed circuit", Fig. 1 #108,109).

36. The programmable controller as claimed in claim 35, wherein said monitoring services and control unit is arranged to:

operate said at least one output register, when said support circuits are operated according to said first condition, to ensure the output data in said at least one output register remains unchanged from the output data last stored from the user control program circuit when said support circuits were operated according to said second condition (e.g., col. 2 lines 30-34: "at any time when the clocks are stopped, the flip-flops will maintain the state of the circuit").

Allowable Subject Matter

Claims 43-49 are allowed (pending correction to the minor claim objections noted above).

The following is a statement of reasons for the indication of allowable subject matter: The prior art of record fails to teach or fairly suggest the features of claims 34 and 37, in combination with the remaining features and elements of the claimed invention. Applicant has incorporated the features of claims 34 and 37 into new independent claims 43 and 47.

Double Patenting

Claims 34 and 37-42 are objected to under 37 CFR 1.75 as being a substantial duplicate of claims 43-49. When two claims in an application are duplicates or else are so close in content that they both cover the same thing, despite a slight difference in wording, it is proper after allowing one claim to object to the other as being a substantial duplicate of the allowed claim. See MPEP § 706.03(k).

For Allowance

Claims 34 and 37-42 are duplicates of claims 43-49 so they should be cancelled, along with the remainder of the rejected claims 3, 4, 22, 33, 35, and 36, and non-elected claims 8-19, 23-26, and 29-31 in order to put the case in a condition for allowance. Also, the minor claim objections noted above should be addressed and corrected.

Election/Restrictions

Claims 8-19, 23-26, 29, and 30 were previously withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected invention, there being no allowable generic or linking claim. Election was made **without** traverse in the reply filed on 06/05/07.

Claim 31 was also previously withdrawn from consideration as being directed to a non-elected invention, based on original presentation. See 37 CFR 1.142(b) and MPEP § 821.03.

Claims 43 and 47 are allowable. The restriction requirement among inventions, as set forth in the Office action mailed on 04/12/07, has been reconsidered in view of the allowability of claims to the elected invention pursuant to MPEP § 821.04(a). **The restriction requirement is hereby withdrawn as to any claim that requires all the limitations of an allowable claim.** Claims 8-19, 23-26, and 29-31, remain withdrawn from further consideration because they do not require all the limitations of an allowable generic linking claim as required by 37 CFR 1.141.

In view of the above noted withdrawal of the restriction requirement, applicant is advised that if any claim presented in a continuation or divisional application is anticipated by, or includes all the limitations of, a claim that is allowable in the present application, such claim may be subject to provisional statutory and/or nonstatutory double patenting rejections over the claims of the instant application. Once a restriction requirement is withdrawn, the provisions of 35 U.S.C. 121 are no longer applicable. See *In re Ziegler*, 443 F.2d 1211, 1215, 170 USPQ 129, 131-32 (CCPA 1971). See also MPEP § 804.01.

Response to Arguments

Applicant's arguments, see pages 24-25, filed 04/16/09, with respect to claims 3, 4, and 34-37 have been fully considered and are persuasive. The previous claim objections have been withdrawn in light of the claim amendments filed 04/16/09.

Applicant's arguments, see pages 25-28, filed 04/16/09, with respect to claims 4, 22, and 33-42 have been fully considered and are persuasive. The rejections of claims 4, 22, and 33-42 under 35 U.S.C. 1st paragraph have been withdrawn in light of the claim amendments filed 04/16/09.

Applicant's arguments, see pages 28-29, filed 04/16/09, with respect to the rejection(s) of claim(s) 3, 4, 22, 33, 35, and 36 under 35 U.S.C. 102(e) as being anticipated by How et al. US 6,611,932 have been fully considered but are not persuasive. Applicant argues that How et al. does not teach a "digital output interface". But this is clearly taught in Fig. 1, for example.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ryan A. Jarrett whose telephone number is (571) 272-3742. The examiner can normally be reached on 10:00-6:30 M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Albert Decady can be reached on (571) 272-3819. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Ryan A. Jarrett/
Examiner, Art Unit 2121

07/21/09